

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

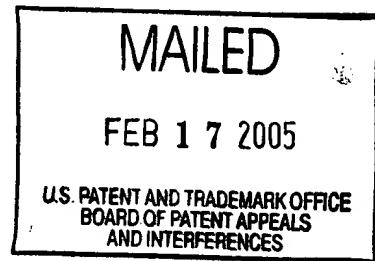
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRAMPTON E. ELLIS, III

Appeal No. 2004-1183
Application No. 09/527,019

ON BRIEF



Before COHEN, FRANKFORT, and McQUADE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is taken from the final rejection of claims 11 through 44, all of the claims that remain in the application.

The appellant's invention addresses an inner shoe, an outer shoe, a removable midsole section sized to fit inside a shoe and form part of the shoe designed to receive and retain the removable midsole section, and an outer shoe for receiving a removable midsole section. An understanding of the invention can be derived from a reading of exemplary claims 11, 23, 25, 32, and

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39, respective copies of which appear in an APPENDIX to the main appeal brief (Paper No. 27).

The examiner has applied the documents listed, infra, as evidence of anticipation and obviousness:

Hoyt	5,425,186	Jun. 20, 1995
Demon	5,813,142	Sep. 29, 1998
Vizy et al	6,023,857	Feb. 15, 2000
		(filing date of Sep. 21, 1998)
Gaudio et al	WO 97/46127	Dec. 11, 1997
(Gaudio)(Adidas AG)	(WO'127)	

The rejections before us for review are as follows.

Claims 11, 14 through 20, 22, and 25 through 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO'127.

Claims 39 through 44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO'127.

Claims 32 through 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 25 above, further in view of Hoyt.

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Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 11 above, further in view of Demon.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 11 above, further in view of Vizy.

Claims 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 11 above, further in view of Hoyt.

Claims 11 through 44 stand provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 11 through 45 of copending Application No. 09/558,629 (provisional double patenting rejection).

Claims 11 through 44 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 through 45 of copending Application No. 09/588,629.

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The examiner's rejections and response to the argument presented by appellant can be found in the answer (Paper No. 28), while appellant's argument appears in the main and reply briefs (Paper Nos. 27 and 29).

In the main brief (page 6), appellant groups the claims on appeal as follows:

Group I - claims 11, 14 through 20, and 22

Group II - claims 12 and 13

Group III - claim 21

Group IV - claim 23¹

Group V - claims 25 through 31

Group VI - claims 32

Group VII - claims 33 through 38

Group VIII - claims 39 through 44

Based upon this grouping of claims and the arguments made on appeal, we shall focus upon claims 11, 12, 21, 25, 32, 33, and 39, infra, as to the prior art rejections on appeal, with the remaining claims of a group standing or falling with the selected claim of that group.

¹ We note that no prior art rejection of claim 23 is before us. This claim is specifically addressed in the remand below.

OPINION

In reaching our conclusion on the anticipation, obviousness, and double patenting issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,² the claims in copending Application No. 09/558,629,³ and the viewpoints of appellant and the examiner, respectively. As a consequence of our review, we make the determinations which follow.

Initially, it is important to recognize, as acknowledged by appellant (main brief, page 32), that the claims of the present application are broader in scope than those of copending Application No. 09/558,629 that recited an insertable midsole

² In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

³ Appellant indicates in the main brief (page 2) that the current appeal may be related to the appeal in U.S. Application No. 09/558,629. This panel of the Board is aware of the decision rendered in Appeal No. 2004-0305 in the referenced application.

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orthotic. In fact, the term "orthotic", at issue in earlier Appeal No. 2004-0305, does not appear at all in any of the claims now before us. Additionally, we observe that appellant's disclosure contemplates a midsole orthotic (Fig. 11B) that can fit within a shoe (Fig. 11C). However, most importantly, it is also made quite clear to us (specification, pages 63 and 64) that the midsole orthotic can include its own integral inner or secondary upper 21a (Fig. 11R), such as a bootie or slipper, with typical attachment means such as laces, straps, Velcro®, and zippers, or simply be a slip-on structure, like a slipper, loafer, or pull-on boot. We are also informed by the present disclosure that the latter orthotic can also have its own thin outer sole 149a of rubber (Fig. 11R) for wear protection and traction so that the insertable midsole orthotic can be worn indoors without the shoe upper 21 and outer sole 149 (Fig. 11C), but can also be inserted into the upper and sole of Fig. 11C for heavier use such as walking outdoors or engaging in athletics. In light of the above, we at once discern that, in its broader aspects, appellant teaches an inner shoe (Fig. 11R), i.e., a midsole orthotic with an upper 21a and rubber outer sole 149a, which can also be inserted into an outer shoe, i.e., an over shoe (Fig. 11C).

Anticipation⁴

We sustain the rejection of claims 11 and 25 under 35 U.S.C. § 102(b) as being anticipated by WO'127. It follows that the respective rejections of claims 14 through 20 and 22 and claims 26 through 31 are likewise sustained since these claims stand or fall with independent claims 11 and 25, as earlier noted.

Independent claim 11 is drawn to an inner shoe which comprises, inter alia, a removable midsole section sized to fit inside and form part of the sole of a shoe designed to receive and retain the removable midsole section, a secondary outer sole,

⁴ Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

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a device for retaining the inner shoe on an intended wearer's foot; and wherein the inner shoe is removable from the shoe in order to wear the inner shoe independently of the shoe.

A reading of claim 11 indicates to us that it addresses an inner shoe *per se* that is removable from a shoe that is designed to receive and retain it (an outer shoe).

As we see it, one versed in the art would readily perceive the shoe of WO'127 (e.g., fig. 21) as being capable of being used with a conventional outer shoe and, thus, nominatively characterized as an inner shoe, as claimed. It is for this reason that the rejection of claim 11 is sustained.

Appellant's argument does not convince us that the anticipation rejection of claim 11 is unsound. The argument presented relative to the content of claim 11 (main brief, pages 6 through 9 and reply brief, pages 1 and 2) focuses upon the permanent attachment of the assembled components of WO'127 that together form the shoe (Figs. 19 through 22). This argument is not persuasive in light of the examiner's discussion of the

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capability of the shoe of WO'127 being removably worn with and without an overshoe (answer, pages 4 and 13).

Independent claim 25 sets forth a removable midsole section sized to fit inside a shoe and form part of the shoe designed to receive and retain said removable midsole section, which comprises, inter alia, a plurality of protrusions on at least one side of the removable midsole section, wherein the protrusions are of sufficient size to interact with the shoe to retain the removable midsole section in the shoe.

From our assessment of claim 25, we derive an understanding that this claim addresses a removable midsole section *per se* that is removable from a shoe that is designed to receive and retain it.

We agree with the examiner (answer, pages 4 through 6) that the anticipation rejection of claim 25 based upon the teaching of WO'127 is sound.

In our opinion, one skilled in the art at issue would readily comprehend the shoe of WO'127 as being capable of being

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used with a conventional outer shoe and, thus, nominatively characterized as a removable midsole section, as claimed. For this reason, the rejection of claim 25 is sustained.

Notwithstanding appellant's arguments to the contrary (main brief, pages 9 through 12 and reply brief, pages 2 and 3), the anticipation rejection of claim 25 is seen to be clearly appropriate when the broad language of claim 25 is considered vis-a-vis the shoe of WO'127 and its capability of being used in conjunction with a conventional outer shoe. Akin to appellant's disclosure, when inserted into an outer shoe, the shoe of WO'127 may fairly be denoted a removable midsole section and part of the outer shoe, as broadly claimed.

We sustain the rejection of claim 39 under 35 U.S.C. § 102(b) as being anticipated by WO'127. The rejection of claims 40 through 44 is also sustained since these claims stand or fall with claim 39, as mentioned above.

Claim 39 sets forth an outer shoe for receiving a removable midsole section which comprises, inter alia, an outer shoe upper and outer shoe sole including at least a bottom sole, and at

least two recesses in the bottom sole to thereby releasably retain the removable midsole section in the outer shoe.

Claim 39 is fairly assessed as being drawn to an outer shoe per se. A removable midsole section is not a positively recited component of the outer shoe of claim 39.

The applied WO'127 reference teaches a shoe that can be reasonably viewed as an outer shoe having an outsole 14 including a bottom sole that includes recesses (Figs. 1 and 20) that are clearly capable of being occupied by midsole protrusions 74, 76, and 78 (Figs. 19 and 22) such that a removable midsole section might be releasably retained therein.

We are not persuaded by the argument of appellant (main brief, pages 14 through 16) that the examiner erred in the anticipation rejection of claim 39. Appellant points out that, in the shoe of WO'127, the midsole is permanently attached to the bottom sole. As indicated above, a removable midsole section is not a positively recited component of the outer shoe set forth in claim 39. As such, claim 39 reads on the shoe upper 16 and shoe outsole 14 of WO'127 (Fig. 22) which upper and outsole are

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clearly capable of receiving a removable and releasable midsole section. As to appellant's particular argument, our latter conclusion is not altered by a combination of shoe elements in WO'127 wherein the midsole is affixed or secured to the outsole. Since prior to securement of such a midsole the outer shoe of WO' 127 (Fig. 22) is unquestionably capable of receiving a removable and releasable midsole section.

Obviousness⁵

We sustain the rejection of claim 32 under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 25 above, further in view of Hoyt. The rejection of claims 33 through 38 is sustained since these claims stand or fall with claim 32 as earlier noted.

Claim 32 sets forth an outer shoe comprising, inter alia, an outer shoe upper and an outer shoe sole including at least a

⁵ The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

bottom sole, at least a portion of said outer shoe sole being formed by a removable midsole section as claimed in claim 25.

In applying the test for obviousness, we conclude that it would have been obvious to one having ordinary skill in the art, from a combined assessment of the teachings of WO'127 and Hoyt, to insert the shoe of WO '127 in a stretchable over shoe, as disclosed by Hoyt. As we see it, the motivation for this modification on the part of one having ordinary skill in the art would have been to simply gain the art recognized protection advantage of an over shoe, as explicitly taught by Hoyt (column 1, lines 9 through 15). Thus, the rejection of claim 32 is sound.

Like the examiner (answer, pages 18 and 19), appellant's argument (main brief, pages 20 through 23 and reply brief, page 4) does not convince us as to the patentability of claim 32. In our view, one of ordinary skill in the art would have recognized the inserted shoe of WO'127 as providing a midsole with protrusions that would interact with the stretchable over shoe of Hoyt to retain it therein. Our view herein is, of course,

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consistent with appellant's own teaching, wherein an inner (midsole) shoe (Fig. 11R) is inserted into an outer (over) shoe (Fig. 11C).

We sustain the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 11 above, further in view of Demon. We also sustain the rejection of claim 13 since it stands or falls with claim 12, as noted above.

Claim 12 depends from claim 11, which latter claim we have addressed relative to the WO '127 disclosure earlier.

When applying the test for obviousness, we reach the conclusion that it would have been obvious to one having ordinary skill in the art, from a collective evaluation of the WO'127 and Demon teachings, to provide the shoe of WO'127 with a least one computer controlled (cushioning) compartment and a computer controller. From our perspective, one having ordinary skill in the art would have had the incentive to make the proposed modification to gain the art recognized advantage of a computer

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controlled compartment with a computer controller, as clearly taught by Demon.

We share the view of the examiner that the arguments advanced by appellant (main brief, pages 26 through 30 and reply brief, pages 4 and 5) are not persuasive as to the patentability of claim 12. Appellant has recognized the Demon teaching in the present disclosure (specification, page 50) as being part of the existing art. For the reasons given above, we readily perceive the obviousness of applying the existing computer controlled compartment feature of Demon to the shoe of WO'127.

We sustain the rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 11 above, further in view of Vizy.

Dependent claim 21 adds an insole to the inner shoe of parent claim 11.

Applying the test for obviousness, this panel of the Board makes the determination that it would have been obvious to one having ordinary skill in the art, from a collective review of the

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teachings of WO'127 and Vizy, to provide the shoe of WO'127 with an insole. In our view, the incentive on the part of one having ordinary skill in the art for making this modification would have simply been to gain the expected benefit of an inner sole; a sock liner inner sole being a well known comfort feature in the art as evidenced by the Vizy disclosure (column 1, lines 6 through 28).

The argument of appellant as to the rejection of claim 21 (main brief, page 30) is not convincing. Appellant's focus is on the content of parent claim 11, not claim 21, and the deficiency of WO'127. As explained earlier, we did not find WO'127 lacking with respect to claim 11. Thus, the rejection of claim 21 is sound and sustained.

We sustain the rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over WO'127, as applied to claim 11 above, further in view of Hoyt. The rejection of claim 26 is sustained since it stands or falls with claim 25, as stated earlier.

We pointed out above that it was our assessment of claim 25 that this claim addresses a removable midsole section *per se* that

is removable from a shoe that is designed to receive and retain it. Thus, we determined that this claim is anticipated by the teaching of WO '127. In the present obviousness rejection, the examiner relies upon the WO'127 disclosure and Hoyt. Clearly, the removable midsole section *per se* of claim 25 would have been suggested by WO'127 irrespective of the Hoyt teaching, using our earlier assessment of the former teaching of WO'127. Anticipation is the epitome of obviousness. Nevertheless, the Hoyt reference buttresses the point earlier made that a shoe such as that of WO'127 is clearly capable of being used with an over shoe, such as the one taught by Hoyt.

For the reasons given above, we are not persuaded by the argument of appellant (main brief, pages 16 through 20) that the obviousness rejection of claim 25 is unsound.

Double Patenting

We cannot sustain the provisional rejection of claims 11 through 44 under 35 U.S.C. § 101 as claiming the same invention as that of claims 11 through 45 of copending Application No. 09/558,629.

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The examiner has not set forth a rejection that compares each claim in the earlier application with the asserted same invention claim in the application now on appeal. Without this detailed showing, the present double patenting rejection provides no substantive basis for review and is, therefore, not sound and cannot be sustained.

A same invention double patenting rejection requires, as argued (main brief, pages 32 and 33) identical subject matter. We noted above that, unlike the earlier application wherein an orthotic midsole is claimed, the present application in most instances provides claims that are broader in scope. In a remand, infra, we do, however, bring to the attention of the examiner, claim 40 (and claims dependent therefrom) in the earlier application, and claim 39 (and claims dependent therefrom) in the current application for a same invention and obviousness-type double patenting assessment.

We cannot sustain the provisional rejection of claims 11 through 44 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 through 45 of copending Application No. 09/558,629.

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The examiner has not given us a claim by claim analysis such that we can review the propriety of an obviousness-type double patenting rejection in the present application. As above, we refer, in particular, to a remand below regarding claim 40 (and claims dependent therefrom) of the present application.

Remand

We remand this application to the examiner to consider the following:

1. the appropriateness of a rejection of claims 23 (drawn to an outer shoe) and 24 under 35 U.S.C. § 103(a) as being unpatentable over WO'127 in view of Hoyt, applying the reasoning addressed in the sustained obviousness rejection of claim 32 (drawn to an outer shoe), supra; and
2. the appropriateness of a provisional same invention and/or an obviousness-type double patenting rejection from a comparison of outer shoe claim 39 (also claims dependent therefrom) in the present application with outer shoe claim 40 (also claims dependent therefrom) in earlier Application No. 09/558,629.

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In summary, this panel of the board has:

sustained the rejection of claims 11, 14 through 20, 22, and 25 through 31 under 35 U.S.C. § 102(b) as being anticipated by WO'127;

sustained the rejection of claims 39 through 44 under 35 U.S.C. § 102(b) as being anticipated by WO'127;

sustained the rejection of claims 32 through 38 under 35 U.S.C. § 103(a) as being unpatentable over WO'127, further in view of Hoyt;

sustained the rejection of claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over WO'127, further in view of Demon;

sustained the rejection of claim 21 rejected under 35 U.S.C. § 103(a) as being unpatentable over WO'127, further in view of Vizy;

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not sustained the provisional rejection of claims 11 through 44 under 35 U.S.C. § 101 as claiming the same invention as that of claims 11 through 45 of copending Application No. 09/558,629 (provisional double patenting rejection); and

not sustained the provisional rejection of claims 11 through 44 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11 through 45 of copending Application No. 09/558,629.

Additionally, we have remanded the application to the examiner to review the two matters discussed above.

The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a remand. 37 CFR § 41.50(e) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) provides that

[w]henever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on

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remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

Regarding any affirmed rejection, 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejections are overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejections, including any timely request for rehearing thereof.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART AND REMANDED



IRWIN CHARLES COHEN
Administrative Patent Judge

Charles E. Frankfurt

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE

JOHN P. McQUADE
Administrative Patent Judge

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